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10/699,051

10/30/2003

Brian R. Reynolds

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04/10/2008

CROMPTON, SEAGER & TUFTE, LLC

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SUITE 800

MINNEAPOLIS, MN 55403-2420

EXAMINER

HOEKSTRA, JEFFREY GERDEN

ART UNIT

PAPER NUMBER

3736

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/699,051

**Applicant(s)**

REYNOLDS ET AL.

**Examiner**

JEFFREY G. HOEKSTRA

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 21, 22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 21, 22 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice of Amendment***

1. In response to the amendment filed on 01/30/2008, amended claim(s) 1, 3, 4, 6-10, 21, and 22, canceled claim(s) 13-20 and 23, and new claim(s) 24-31 is/are acknowledged. The current rejections of the claim(s) 1-12, 21, and 22 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Claim Objections***

2. Claims 1, 3, 4, 6, 26 are objected to because of the following informalities: the positive recitations of "the coil tension" appear to lack antecedent basis and may render the claims indefinite. Appropriate correction is required. The Examiner notes Applicant may have intended to positively recite "the tension within the coil" or the like.
3. Claims 7, 8, 9, 24, 25, 30, and 31 are objected to because of the following informalities: the positive recitations of "the shape" appear to lack antecedent basis and may render the claims indefinite. Appropriate correction is required. The Examiner notes Applicant may have intended to positively recite "a shape" or the like.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-12, 21, 22, and 24-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Sharrow (US 2004/0167438 A1).

6. The Examiner notes Sharrow (US 2004/0167438 A1) incorporates by reference (Sharrow paragraphs 24, 34, and 41), the following:

- Zhou et al. (US 2004/0143239 A1, hereinafter Zhou),
- Reynolds et al. (US 2004/0167441 A1, hereinafter Reynolds\_1),
- Nguyen et al. (US 5,772,609, hereinafter Nguyen),
- Palermo (US 6,139,510),
- Skujins et al. (US 6,918,882 B2, hereinafter Skujins), and
- Reynolds et al. (US 7,074,197 B2, hereinafter Reynolds\_2).

7. For claims 1-12, 21, and 22, Sharrow discloses a method for manufacturing an intracorporeal medical device (10), comprising the steps of:

- providing an elongate core member (14) having a proximal region (16) and a distal region (18) (paragraphs 16-28) (as best seen in Figure 2);
- distally and/or proximally disposing a smooth thermoplastic polymer jacket (20) over said elongate core member (paragraphs 29-31) (as best seen in Figure 2), the polymer jacket having a substantially smooth outer surface (paragraphs 29-31);
- winding in tension a coil (12) (the conventional winding technique as positively recited in paragraph 36) including fluorocarbon materials (the high performance PTFE polymer positively recited in paragraphs 30 and 36) (see specification page 7 lines 1-2) over the outer surface of said polymer jacket (paragraphs 32-

- 39), wherein the coil includes an outer fluorocarbon-containing coating (paragraphs 32-39) (the high performance PTFE polymer positively recited in paragraphs 30 and 36) (see specification page 7 lines 1-2), wherein the coil includes a central core material and an outer coating surrounding the central core material (paragraphs 35, 36, and 39) (Zhou paragraphs 29-31, 38, and 56);
- heating said polymer jacket (paragraphs 36-38), relieving the tension within the coil is relieve and the coil (paragraphs 36-38), and embedding the coil in said polymer jacket (paragraphs 36-38), wherein in the heating/tension-relieving/embedding the coil moves radially inward into the polymer jacket and a portion of the outer surface of the polymer jacket wicks outward between the adjacent windings of the coil (paragraphs 36-38), thereby altering the shape of the outer surface of the polymer jacket (paragraphs 36-38) and providing an outer surface of the polymer jacket relative to the coil that has desirable flexibility characteristics (paragraphs 2, 3, and 37); and
  - disposing a covering (22) over said jacket/coil member (paragraph 41).

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-12, 21, 22, and 24-31 have been considered but are moot in view of the new ground(s) of rejection, wherein the new ground(s) of rejection relies upon a different interpretation of previously applied prior art applied to amended and new claims. However in the interest of advancing prosecution and in lieu of previously applied prior art, the Examiner notes the following:

9. Applicant's arguments filed 01/30/2008 have been fully considered but they are not persuasive. Applicant argues the anticipatory rejection of the claims under Sharrow, specifically arguing Sharrow does not disclose, teach, and/or fairly suggest the following: (a) heating said polymer jacket, relieving the tension within the coil is relieve and the coil, and embedding the coil in said polymer jacket, wherein in the heating/tension-relieving/embedding the coil moves radially inward into the polymer jacket and a portion of the outer surface of the polymer jacket wicks outward between the adjacent windings of the coil, thereby altering the shape of the outer surface of the polymer jacket and providing an outer surface of the polymer jacket relative to the coil that has desirable flexibility characteristics; (b) the coil includes a fluorocarbon material ; or (c) the coil includes a central core material and an outer coating surrounding the central core material. The Examiner disagrees, maintains the rejection as set forth above, and notes in response the following:

10. In response to Applicant's argument (a), the Examiner notes Sharrow discloses heating said polymer jacket (paragraphs 36-38), relieving the tension within the coil is relieve and the coil (paragraphs 36-38), and embedding the coil in said polymer jacket (paragraphs 36-38), wherein in the heating/tension-relieving/embedding the coil moves radially inward into the polymer jacket and a portion of the outer surface of the polymer jacket wicks outward between the adjacent windings of the coil (paragraphs 36-38) thereby altering the shape of the outer surface of the polymer jacket (paragraphs 36-38), and providing an outer surface of the polymer jacket relative to the coil that has desirable flexibility characteristics (paragraphs 2, 3, and 37)

11. In response to Applicant's argument (b), the Examiner notes Sharrow discloses the coil includes a fluorocarbon material (paragraphs 32-39) (the high performance PTFE polymer positively recited in paragraphs 30 and 36) (see specification page 7 lines 1-2).

12. In response to Applicant's argument (c), the Examiner notes Sharrow discloses the coil includes a central core material and an outer coating surrounding the central core material (paragraphs 35, 36, and 39) (Zhou paragraphs 29-31, 38, and 56).

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is

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(571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J.H./

Jeff Hoekstra

Examiner, Art Unit 3736

/Max Hindenburg/

Supervisory Patent Examiner, Art Unit 3736